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| THOMSON LICENSING INC. PATENT OPERATIONS PO BOX 5312 PRINCETON, NJ 08543-5312 | | | | PSITOS, ARISTOTELIS M |
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/579,736
Filing Date: May 26, 2000
Appellant(s): BUCHLER ET AL.

MAILED

SEP 13 2005

Patricia A. Verlangieri
For Appellant

Technology Center 2600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/2/05.

After reviewing appellants' arguments, the rejection(s) of claims 11 and 12 are no longer maintained, i.e., these claims are objected to and would be allowable over the art of record if rewritten in independent form to include all the limitations of its respective parent claim.

The rejection predicated upon JP 10-198981 is no longer maintained.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because as disclosed the claimed "impermissible sequence of edges" is found at page 4 lines 29-34 and not at page 9 lines 8-16 or page 9 lines 6-10 as indicated by appellants.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-10,13 and 17 & 1-3,6,9,10 and 17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,317,396

Kuribayashi

11-2001

(10) Grounds of Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1) Claims 1-3,6,9,10 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuribayashi.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The following analysis is made:

| Claim 1 | Kuribayashi |
|---|--|
| An apparatus for reading from or writing to optical recording media, comprising: | see abstract/title discussion of figures 1- 15 |
| a photodetector with at least two detector elements; | element 11 in figure 1 for instance |
| a phase forming unit for detecting a phase difference between output signals of the photodetector: | element 21-23 in figure 1 for instance of elements 20-40 in figure 3 for instance |
| an edge sequence detector for detecting a sequence of edges of the output signals; and | see the description of figure 5 starting at column 5 lines 18-53 for instance |
| a signal-blocking unit for blocking an output signal of the phase forming unit when an impermissible sequence of edges is detected. | see above description of figure 5 with respect to the DISABLE signal |

In the above analysis, the examiner indicates where the claimed elements are found.

With respect to method claims 10 and 17, such are met when the system operates.

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With respect to claims 2,3,6 see the discussion with respect to figure 3, starting at col. 4, lines 3.

With respect to claim 9, see the discussion with respect to figure 4 & 5 starting at col. 4, line 48 and continuing to col. 5 line 53. The fault indicator is considered established when/as the disable signal is generated.

(11) Response to Argument

a) On pages 12-13 of the brief, appellants argue that Kuribayashi lacks the claimed elements, and that Kuribayashi teaches a completely different arrangement in which tracking error signals are detected based on evaluation target signals and hence claims 1-3,6 and 9 are not met.

The above analysis with respect to these claims and the Kuribayashi reference is repeated.

Note again the disclosure commencing at col. 5 lines 15 to col. 6 line 25, wherein a pattern is relied upon. The examiner interprets such as meeting the sequence requirement, and the disabling of the gate circuit is operational when an "impermissible sequence" exists.

The examiner concludes that the elements claimed are indeed met and that the disclosure of the Kuribayashi reference further supports the rejection. Again with respect to the "impermissible sequence", the examiner cannot agree with appellants' interpretation of the CLAIMED subject matter of claim 1, because the examiner concludes such is an impermissible incorporation of limitation(s) from the disclosure into the claim language to define the invention. Such is believed improper in view of In re Sporck (CCPA 155 USPQ 687).

e) On page 13 of the brief, appellants argue that the Kuribayashi system does not meet the claimed method limitations.

The examiner respectfully disagrees for the reason(s) as stated above in the analysis of the Kuribayashi reference.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP
August 23, 2005

Conferees

W. Young

W. Korzuch

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